

**BL O/1014/24**

**TRADE MARKS ACT 1994**

**IN THE MATTER OF  
TRADE MARK APPLICATION NO. 3979662  
BY RAPID INFORMATION SYSTEMS LIMITED TO REGISTER AS A TRADE  
MARK:**



**IN CLASS 09**

**AND**

**IN THE MATTER OF OPPOSITION THERETO UNDER NO. 600003184  
BY RAPID ANSWERS LIMITED**

## **BACKGROUND AND PLEADINGS**

1. On 15 November 2023, Rapid Information Systems Limited (“the applicant”) applied to register the trade mark displayed on the cover page of this decision, under number 3979662 (“the application”). It was accepted and published in the Trade Marks Journal on 29 December 2023 in respect of the following goods:

Class 09: Software; Computer software; Computer software packages; Software for computers; Enterprise software; Computer software development tools; Workflow software; Computer software applications; Software applications; Application software; Business software; Mobile software; Business technology software.

2. On 25 January 2024, the application was opposed by Rapid Answers Limited (“the opponent”) by way of the fast track opposition procedure. The opposition is brought under sections 5(1), 5(2)(a) and 5(2)(b) of the Trade Marks Act 1994 (“the Act”) and is directed against all of the goods specified in the application.

3. The opponent relies upon the following trade mark:

### **RAPID**

UK Trade Mark registration number UK00003036505

Filing date: 02 January 2014

Registration date: 18 April 2014

Relying on the following goods:

Class 09: Computer software for use in retail, catering and related industries.

4. By virtue of its earlier filing date, the above registration constitutes an earlier mark within the meaning of section 6 of the Act. As the mark had completed its registration process more than five years before the filing date of the contested mark, it is subject to the proof of use provisions contained in section 6A of the Act. As a result, and because the opponent brought the opposition under the fast track procedure,<sup>1</sup> the opponent was required to file its evidence of use together with its notice of opposition, which it did do.
5. The applicant filed a counterstatement wherein it elected to request proof of use. As above, the opponent (by electing to bring fast track opposition proceeding), was already required to prove use of its mark. In respect of the claims against it, the applicant denied that the logo included in its mark is in any way similar to the opponent's mark and, therefore, it does not believe there to be any confusion between the two companies. The applicant goes on to state that their application includes an image of a lens with separate segments followed by the word RAPID, whereas the opponent's mark is text only. Additionally, they argue that their mark is presented in Google Ubuntu font and in a navy blue colour, whereas the opponent's mark appears to be presented in Times New Roman font and in black. Finally, the applicant states that the two companies operate in different sectors and therefore there is limited scope for confusion.
6. Neither party is legally represented. Rule 62(5) (as amended) states that arguments in fast track proceedings shall be heard orally only if (i) the Office requests it or (ii) either party to the proceedings requests it and the registrar considers that oral proceedings are necessary to deal with the case justly and at proportionate cost; otherwise, written arguments will be taken. A hearing was neither requested nor considered necessary and I note that neither party filed written submissions in lieu.
7. The provisions of the Act relied upon in these proceedings are assimilated law, as they are derived from EU law. Although the UK has left the EU, section

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<sup>1</sup> Which does not ordinarily include evidence rounds.

6(3)(a) of the European Union (Withdrawal) Act 2018 (as amended by Schedule 2 of the Retained EU Law (Revocation and Reform) Act 2023) requires tribunals applying assimilated law to follow assimilated EU case law. That is why this decision refers to decisions of the EU courts which predate the UK's withdrawal from the EU.

## **EVIDENCE**

8. The opponent's evidence, which was filed with its notice of opposition, consists of 9 exhibits. The statement of truth accompanying the evidence was given by Andrew Routledge who is the Managing Director of the opponent. His statement of truth is dated 25 January 2024. Whilst I do not propose to summarise the evidence here, I have taken all of the evidence into consideration in reaching my decision and will refer to it where necessary below.

## **Proof of use**

9. The relevant statutory provisions are set out in Section 6A of the Act, which states:

“(1) This section applies where -

(a) an application for registration of a trade mark has been published,

(b) there is an earlier trade mark of a kind falling within section 6(1)(a), (aa) or (ba) in relation to which the conditions set out in section 5(1), (2) or (3) obtain, and

(c) the registration procedure for the earlier trade mark was completed before the start of the relevant period.

(1A) In this section “the relevant period” means the period of 5 years ending with the date of the application for registration mentioned in

subsection (1)(a) or (where applicable) the date of the priority claimed for that application.

(2) In opposition proceedings, the registrar shall not refuse to register the trade mark by reason of the earlier trade mark unless the use conditions are met.

(3) The use conditions are met if -

(a) within the relevant period the earlier trade mark has been put to genuine use in the United Kingdom by the proprietor or with his consent in relation to the goods or services for which it is registered, or

(b) the earlier trade mark has not been so used, but there are proper reasons for non- use.

(4) For these purposes -

(a) use of a trade mark includes use in a form (the “variant form”) differing in elements which do not alter the distinctive character of the mark in the form in which it was registered (regardless of whether or not the trade mark in the variant form is also registered in the name of the proprietor), and

(b) use in the United Kingdom includes affixing the trade mark to goods or to the packaging of goods in the United Kingdom solely for export purposes.

(5)- (5A) [Repealed]

(6) Where an earlier trade mark satisfies the use conditions in respect of some only of the goods or services for which it is registered, it shall be treated for the purposes of this section as if it were registered only in respect of those goods or services.”

10. Section 100 is also relevant, which reads:

“If in any civil proceedings under this Act a question arises as to the use to which a registered trade mark has been put, it is for the proprietor to show what use has been made of it.”

11. In accordance with the above provisions, the relevant period for proving use is that five-year period prior to the filing date of the applicant’s mark, being 15 November 2018. As a result, the relevant period is 16 November 2018 to 15 November 2023.

12. In *easyGroup Ltd v Nuclei Ltd & Ors* [2023] EWCA Civ 1247, Arnold LJ summarised the law relating to genuine use as follows:

“105. The principles applicable to determining whether there has been genuine use of a trade mark have been considered by the CJEU in a considerable number of cases, the principal decisions being Case C-40/01 *Ansul BV v Ajax Brandbeveiliging BV* [2003] ECR I-2439, Case C-259/02 *La Mer Technology Inc v Laboratories Goemar SA* [2004] ECR I-1159, Case C-416/04 P *Sunrider Corp v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [2006] ECR I-4237, Case C-442/07 *Verein Radetsky-Order v Bunderversvereinigung Kamaradschaft 'Feldmarschall Radetsky* [2008] ECR I-9223, Case C-495/07 *Silberquelle GmbH v Maselli-Strickmode GmbH* [2009] ECR I-2759, Case C-149/11 *Leno Merken BV v Hagelkruis Beheer BV* [EU:C:2012:816], Case C-609/11 *Centrotherm Systemtechnik GmbH v Centrotherm Clean Solutions GmbH & Co KG* [EU:C:2013:592], Case C-141/13 *P Reber Holding & Co KG v Office for Harmonisation in the Internal Market (Trade Marks and Designs)* [EU:C:2014:2089], Case C-689/15 *W.F. Gözze Frottierweberei GmbH v Verein Bremer Baumwollbörse* [EU:C:2017:434] and Joined Cases C–720/18 and C–721/18 *Ferrari SpA v DU* [EU:C:2020:854].

106. Ignoring issues which do not arise in the present case, such as use in relation to spare parts or second-hand goods and use in relation to a sub-category of goods or services, the principles may be summarised as follows:

(1) Genuine use means actual use of the trade mark by the proprietor or by a third party with authority to use the mark: *Ansul* at [35] and [37].

(2) The use must be more than merely token, that is to say, serving solely to preserve the rights conferred by the registration of the mark: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Centrotherm* at [71]; *Leno* at [29]; *Ferrari* at [32].

(3) The use must be consistent with the essential function of a trade mark, which is to guarantee the identity of the origin of the goods or services to the consumer or end user by enabling him to distinguish the goods or services from others which have another origin: *Ansul* at [36]; *Sunrider* at [70]; *Verein* at [13]; *Silberquelle* at [17]; *Centrotherm* at [71]; *Leno* at [29]; *Gözze* at [37], [40]; *Ferrari* at [32].

(4) Use of the mark must relate to goods or services which are already marketed or which are about to be marketed and for which preparations to secure customers are under way, particularly in the form of advertising campaigns: *Ansul* at [37]. Internal use by the proprietor does not suffice: *Ansul* at [37]; *Verein* at [14]. Nor does the distribution of promotional items as a reward for the purchase of other goods and to encourage the sale of the latter: *Silberquelle* at [20]-[21]. But use by a non-profit making association can constitute genuine use: *Verein* at [16]-[23].

(5) The use must be by way of real commercial exploitation of the mark on the market for the relevant goods or services, that is to say, use in accordance with the commercial *raison d'être* of the mark, which is to create or preserve an outlet for the goods or services that bear the mark: *Ansul* at [37]-[38]; *Verein* at [14]; *Silberquelle* at [18]; *Centrotherm* at [71].

(6) All the relevant facts and circumstances must be taken into account in determining whether there is real commercial exploitation of the mark, including: (a) whether such use is viewed as warranted in the economic sector concerned to maintain or create a share in the market for the goods and services in question; (b) the nature of the goods or services; (c) the

characteristics of the market concerned; (d) the scale and frequency of use of the mark; (e) whether the mark is used for the purpose of marketing all the goods and services covered by the mark or just some of them; (f) the evidence that the proprietor is able to provide; and (g) the territorial extent of the use: *Ansul* at [38] and [39]; *La Mer* at [22]-[23]; *Sunrider* at [70]-[71], [76]; *Centrotherm* at [72]-[76]; *Reber* at [29], [32]-[34]; *Leno* at [29]-[30], [56]; *Ferrari* at [33].

(7) Use of the mark need not always be quantitatively significant for it to be deemed genuine. Even minimal use may qualify as genuine use if it is deemed to be justified in the economic sector concerned for the purpose of creating or preserving market share for the relevant goods or services. For example, use of the mark by a single client which imports the relevant goods can be sufficient to demonstrate that such use is genuine, if it appears that the import operation has a genuine commercial justification for the proprietor. Thus, there is no *de minimis* rule: *Ansul* at [39]; *La Mer* at [21], [24] and [25]; *Sunrider* at [72]; *Leno* at [55].

(8) It is not the case that every proven commercial use of the mark may automatically be deemed to constitute genuine use: *Reber* at [32].”

13. Consequently, the onus is upon the opponent to prove that genuine use of the earlier marks was made within the relevant territory in the relevant period, and in respect of the relevant goods as registered.
14. Whether the use shown is sufficient for this purpose will depend on whether there has been real commercial exploitation of the marks, in the course of trade, sufficient to create or maintain a market for the goods at issue in the UK during the relevant five-year period. In making the assessment, I am required to consider all relevant factors, including:
  - i) The scale and frequency of the use shown.
  - ii) The nature of the use shown.
  - iii) The goods for which use has been shown.
  - iv) The nature of those goods and the market(s) for them.

- v) The geographical extent of the use shown.

### **Genuine Use**

15. As indicated in the case law cited above, use does not always need to be quantitatively significant to be genuine. The assessment must take into account a number of factors in order to ascertain whether there has been real commercial exploitation of the mark which can be regarded as “warranted in the economic sector concerned to maintain or create a share in the market for the goods or services protected by the mark”.
16. The opponent claims to have used its earlier mark ‘RAPID’ in relation to the following goods:
  - Class 09: Computer software for use in retail, catering and related industries.
17. Exhibit 1 consists of a copy of the opponent’s original trade mark certificate from 2014, as well as a certificate showing a company name change from RETAIL ANSWERS LIMITED to RAPID ANSWER LIMITED in 2021. The opponent confirms that the software product has always been called RAPID since its original incorporation in 1996. Exhibit 2 consists of a copy of a presentation for the catering industry promoting the opponent’s software product called RAPID. Exhibits 3 and 4 consist of a copy of a brochure demonstrating the functionality of their software in relation to the catering and retail industries. Exhibit 5 consists of an example of the opponent’s approved new logo in 2020. Exhibits 6 and 7 consist of two invoices for the monthly RAPID license and maintenance fees. Exhibit 8 Shows the revenue generated from the sales of the opponent’s RAPID software from 2005-2022. Again, the opponent confirms that the RAPID software product is the only good sold by the opponent, and therefore 100% of the revenue generated is done so from sales of this product. Exhibit 9 is a copy of a proposal document template.

18. As stated above, the opponent has provided revenue figures relating to sales of the relevant goods. Below is an extract covering the relevant period, however, these figures also go back as far as 2005:

2017-18	2018-19	2019-20	2020-21	2021-22
2,470				
			2,000	13,000
13,536	13,536	16,920	13,536	7,896
8,500				
2,000	13,396			
45,481	41,669	29,211	34,238	39,801
11,164	6,870	5,153	1,718	
10,185	36,134	40,624	28,747	33,488
<b>93,335</b>	<b>111,605</b>	<b>91,908</b>	<b>80,238</b>	<b>94,185</b>

19. In considering the evidence as whole it appears to be lacking in respect of advertising spend, as well as reach of the promotional materials provided. Additionally, while assessing the evidence I bear in mind the size of the market at issue, namely the software industry. Whilst I have no evidence supplied by either party on the size of the market, it is considered that the software industry in the UK is sizeable, with a vast number of companies providing different kinds of software goods. However, I bear in mind that the opponent's specification is limited to the catering, retail, and related industries and in that regard the size of the market is likely to be smaller. Nevertheless, the above turnover figures are considered to be modest. However, I remain mindful of what was said in *easyGroup* that use of the mark need not always be quantitatively significant for it to be deemed genuine. Having considered the evidence as a whole it is my view that the opponent has successfully provided sufficient evidence to justify genuine use during the relevant period for the purpose of creating or preserving market share for the relevant goods.

## DECISION

### Sections 5(1) & 5(2)(a)

20. Sections 5(1) and 5A of the Act read as follows:

“5(1) A trade mark shall not be registered if it is identical with an earlier trade mark and the goods or services for which the trade mark is applied for are identical with the goods or services for which the earlier trade mark is protected.”

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

21. Sections 5(2)(a) and 5A of the Act read as follows:

“5(2) A trade mark shall not be registered if because –

(a) it is identical with an earlier trade mark and is to be registered for goods or services similar to those for which the earlier trade mark is protected, [...]

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark.

“5A Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the Page 18 of 40 trade mark is applied for, the application is to be refused in relation to those goods and services only.”

### **Identity of the marks**

22. In order for a claim under section 5(1) or 5(2)(a) of the Act to succeed, the competing marks are required to be identical. The question of when a mark may be considered identical to another was addressed in *S.A. Société LTJ Diffusion*

*v. Sadas Vertbaudet SA*, Case C-291/00, where the Court of Justice of the European Union (“CJEU”) held that:

“54. [...] a sign is identical with the trade mark where it reproduces, without any modification or addition, all the elements constituting the trade mark or where, viewed as a whole, it contains differences so insignificant that they may go unnoticed by an average consumer.”

23. Clearly, the applicant’s mark includes a separate figurative element, described as an image of a lens with separate segments, placed in front of the word RAPID. This element is not present in the opponent’s earlier mark. As the guidance above states the differences must be ‘so insignificant that they may go unnoticed’. Bearing this in mind, I find the inclusion of the additional figurative element in the applicant’s mark is not *so insignificant* that it may go unnoticed, but instead is clearly identifiable and obvious. As a result, it is considered that the two marks are not identical.
24. Having found that the applicant’s mark and the earlier mark relied on by the opponent are not identical, the opposition brought under sections 5(1) and 5(2)(a) fail.

### **Section 5(2)(b): legislation and case law**

25. Section 5(2)(b) of the Act reads as follows:

“5 (2) A trade mark shall not be registered if because –

[...]

(b) it is similar to an earlier trade mark and is to be registered for goods or services identical with or similar to those for which the earlier trade mark is protected,

there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the earlier trade mark”

26. Section 5A of the Act states as follows:

“Where grounds for refusal of an application for registration of a trade mark exist in respect of only some of the goods or services in respect of which the trade mark is applied for, the application is to be refused in relation to those goods and services only.”

27. The following principles are gleaned from the decisions of the EU courts in *Sabel BV v Puma AG*, Case C-251/95, *Canon Kabushiki Kaisha v Metro-Goldwyn-Mayer Inc*, Case C-39/97, *Lloyd Schuhfabrik Meyer & Co GmbH v Klijsen Handel B.V.* Case C-342/97, *Marca Mode CV v Adidas AG & Adidas Benelux BV*, Case C-425/98, *Matratzen Concord GmbH v OHIM*, Case C-3/03, *Medion AG v. Thomson Multimedia Sales Germany & Austria GmbH*, Case C-120/04, *Shaker di L. Laudato & C. Sas v OHIM*, Case C-334/05P and *Bimbo SA v OHIM*, Case C-591/12P.

**The principles:**

(a) The likelihood of confusion must be appreciated globally, taking account of all relevant factors;

(b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind, and whose attention varies according to the category of goods or services in question;

(c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details;

(d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components, but it is only when all other components of a complex mark are negligible that it is permissible to make the comparison solely on the basis of the dominant elements;

(e) nevertheless, the overall impression conveyed to the public by a composite trade mark may be dominated by one or more of its components;

(f) however, it is also possible that in a particular case an element corresponding to an earlier trade mark may retain an independent distinctive role in a composite mark, without necessarily constituting a dominant element of that mark;

(g) a lesser degree of similarity between the goods or services may be offset by a great degree of similarity between the marks, and vice versa;

(h) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it;

(i) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient;

(j) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense;

(k) if the association between the marks creates a risk that the public might believe that the respective goods or services come from the same or economically linked undertakings, there is a likelihood of confusion.

## Comparison of goods

28. Section 60A of the Act provides:

“(1) For the purpose of this Act goods and services-

(a) are not to be regarded as being similar to each other on the ground that they appear in the same class under the Nice Classification.

(b) are not to be regarded as being dissimilar from each other on the ground that they appear in different classes under the Nice Classification.

(2) In subsection (1), the “Nice Classification” means the system of classification under the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks of 15 June 1957, which was last amended on 28 September 1979.”

29. For the purposes of considering the issue of similarity of goods, it is permissible to consider groups of terms collectively where they are sufficiently comparable to be assessed in essentially the same way and for the same reasons (see *Albingia SA v Axis Bank Limited*, BL O/253/18, a decision of the Appointed Person, Professor Phillip Johnson, at paragraph 42).

30. In *Gérard Meric v Office for Harmonisation in the Internal Market*, Case T 133/05, the General Court stated that:

“29. In addition, the goods can be considered as identical when the goods designated by the earlier mark are included in a more general category, designated by trade mark application (Case T-388/00 Institut for Lernsysteme v OHIM – Educational Services (ELS) [2002] ECR II-4301, paragraph 53) or where the goods designated by the trade mark

application are included in a more general category designated by the earlier mark.”

31. In the judgment of the Court of Justice of the European Union (“CJEU”) in *Canon*, Case C-39/97, the court stated at paragraph 23 of its judgment that:

“In assessing the similarity of the goods or services concerned, as the French and United Kingdom Governments and the Commission have pointed out, all the relevant factors relating to those goods or services themselves should be taken into account. Those factors include, inter alia, their nature, their intended purpose and their method of use and whether they are in competition with each other or are complementary.”

32. The relevant factors identified by Jacob J. (as he then was) in the *Treat* case, [1996] R.P.C. 281, for assessing similarity were:

(a) The respective uses of the respective goods or services;

(b) The respective users of the respective goods or services;

(c) The physical nature of the goods or acts of service;

(d) The respective trade channels through which the goods or services reach the market;

(e) In the case of self-serve consumer items, where in practice they are respectively found or likely to be, found in supermarkets and in particular whether they are, or are likely to be, found on the same or different shelves;

(f) The extent to which the respective goods or services are competitive. This inquiry may take into account how those in trade classify goods, for instance whether market research companies, who of course act for industry, put the goods or services in the same or different sectors.

33. In *YouView TV Ltd v Total Ltd*, [2012] EWHC 3158 (Ch), Floyd J. (as he then was) stated that:

“... Trade mark registrations should not be allowed such a liberal interpretation that their limits become fuzzy and imprecise: see the observations of the CJEU in Case C-307/10 *The Chartered Institute of Patent Attorneys (Trademarks) (IP TRANSLATOR)* [2012] ETMR 42 at [47]-[49]. Nevertheless the principle should not be taken too far. Treat was decided the way it was because the ordinary and natural, or core, meaning of 'dessert sauce' did not include jam, or because the ordinary and natural description of jam was not 'a dessert sauce'. Each involved a straining of the relevant language, which is incorrect. Where words or phrases in their ordinary and natural meaning are apt to cover the category of goods in question, there is equally no justification for straining the language unnaturally so as to produce a narrow meaning which does not cover the goods in question”.

34. In *Avnet Incorporated v Isoact Limited*, [1998] F.S.R. 16, Jacob J. (as he then was) stated that:

“In my view, specifications for services should be scrutinised carefully and they should not be given a wide construction covering a vast range of activities. They should be confined to the substance, as it were, the core of the possible meanings attributable to the rather general phrase.”

35. The goods to be compared are:

<b>The opponent's goods</b>	<b>The applicant's goods</b>
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<p><b>Class 09:</b> Computer software for use in retail, catering and related industries.</p>	<p><b>Class 09:</b> Software; Computer software; Computer software packages; Software for computers; Enterprise software; Computer software development tools; Workflow software; Computer software applications; Software applications; Application software; Business software; Mobile software; Business technology software.</p>
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36. In their counterstatement the applicant states that their software is not in the catering or retail sector and therefore there is limited scope for confusion. Whilst this is noted, it is important to state that the applicant's intention is not relevant, and I must consider a notional assessment of the terms as presented before me in the applicant's specification.

*Software; Computer software; Computer software packages; Software for computers; Enterprise software; Workflow software; Computer software applications; Software applications; Application software; Business software; Mobile software; Business technology software.*

37. It is clear that these goods are identical to the opponent's *Computer software for use in retail, catering and related industries*. This is on the basis that the applicant's terms are broad enough to encompass the opponent's. The applicant's goods are not limited in any way and, therefore, even terms such as 'Enterprise software' and 'Workflow software' are considered broad enough to encompass software for use in any industry, be that retail, catering and any related industries. Therefore, as per the principals set out in *Meric*, these goods are considered identical.

38. However, if I am wrong in this finding, I will consider some of the terms separately below.

*Enterprise software; Workflow software; Business software; Business technology software.*

39. In general, these terms are broad enough to cover a number of different purposes, for example, for use in the recruitment or financial industry. Whilst it is noted that the opponent's goods are computer software, they are specifically restricted to the retail, catering and related industries. Accordingly, if it can be said that the competing terms at issue may have different core purposes then there is no overlap in purpose between the goods. Having said that, the nature and methods of use for these goods may overlap to some degree on the basis that the goods at issue are all items of software that will be used in the ordinary way. Further, I consider that due to the unrestricted nature of the above terms, it is considered that users may overlap as would the trade channels. As a result, I considered the goods to be similar to at least a medium degree.

#### **The average consumer and the nature of the purchasing act**

40. The average consumer is deemed to be reasonably well informed and reasonably observant and circumspect. For the purpose of assessing the likelihood of confusion, it must be borne in mind that the average consumer's level of attention is likely to vary according to the category of goods or services in question (see *Lloyd Schuhfabrik Meyer*, Case C-342/97).
41. In *Hearst Holdings Inc, Fleischer Studios Inc v A.V.E.L.A. Inc, Poeticgem Limited, The Partnership (Trading) Limited, U Wear Limited, J Fox Limited*, [2014] EWHC 439 (Ch), Birss J. described the average consumer in these terms:

“60. The trade mark questions have to be approached from the point of view of the presumed expectations of the average consumer who is reasonably well informed and reasonably circumspect. The parties were agreed that the relevant person is a legal construct and that the test is to be applied objectively by the court from the point of view of that

constructed person. The words “average” denotes that the person is typical. The term “average” does not denote some form of numerical mean, mode or median.”

42. The opponent’s software products have been qualified as “for use in retail, catering and related industries”, therefore I consider the average consumer of the Class 9 goods to be professional users within the retail and catering industries. A number of the Class 09 goods covered by the applicant’s mark have not been limited to any particular field, however others specify ‘business’ or ‘enterprise’ software. Given their technical nature, I consider that a significant proportion of the average consumer of the goods will be professional users such as businesses seeking software solutions in order to run their businesses, be that within the retail or catering industry or otherwise. Additionally, as some of the applied for goods are so broad e.g. ‘software’ at large, it is considered that the average consumer for these goods could be any member of the general public too.
  
43. Given the nature of some of the restricted software goods, they are likely to be purchased relatively infrequently. However, for the general software goods they are likely to be purchased quite frequently. I would expect them to be sold through specialist and non-specialist retailers, be that from bricks and mortar premises, through tele-sales, or via the internet. For the specialist software goods, the selection of the goods will be relatively important to the average consumer, with the purchasing act likely to follow a measured thought process such that the goods are unlikely to be purchased casually or as a matter of routine. Regardless of the identity of the average consumer, considerations such as technical reviews of the software, price, quality, ease of use, suitability of the product and the reputation of the provider would be taken into account before purchasing. That being said, I appreciate that some software goods purchased by the general public may include a subcategory of goods that are likely to be casual purchases, for example, in the form of free downloadable mobile apps or mobile games. The selection process would be a combination of visual and aural; some consumers would seek information from written reviews and recommendations, particularly on the internet, whereas others

would receive verbal advice from sales representatives, particularly in the case of tele-sales. I consider that for the specialist software goods, the average consumer will want to ensure that the software procured is appropriate to specific business needs, and as such, they will pay a higher-than-average degree of attention during the purchasing act. However, for the general software goods, that are frequently purchased by the public at large, the level of attention is likely to be between low and medium. I say this because these types of software goods can be purchased very cheaply, if not downloaded for free, via app stores on mobile devices.


### **Comparison of trade marks**

44. It is clear from *Sabel BV v. Puma AG* (particularly paragraph 23) that the average consumer normally perceives a trade mark as a whole and does not proceed to analyse its various details. The same case also explains that the visual, aural and conceptual similarities of the trade marks must be assessed by reference to the overall impressions created by the trade marks, bearing in mind their distinctive and dominant components. The CJEU stated at paragraph 34 of its judgement in Case C-591/12P, *Bimbo SA v OHIM*, that:

“.....it is necessary to ascertain, in each individual case, the overall impression made on the target public by the sign for which registration is sought, by means of, inter alia, an analysis of the components of a sign and of their relative weight in the perception of the target public, and then, in the light of that overall impression and all factors relevant to the circumstances of the case, to assess the likelihood of confusion”.

45. It would be wrong, therefore, to artificially dissect the trade marks, although it is necessary to take into account the distinctive and dominant components of the trade marks and to give due weight to any other features which are not negligible and therefore contribute to the overall impressions created by the trade marks.

46. The trade marks to be compared are as follows:

The opponent's mark	The applicant's mark
UK00003036505  <b>RAPID</b>	UK00003979662   <b>RAPID</b>

### Overall Impression

47. The opponent's mark consists solely of the word 'RAPID'. There are no other elements in the mark to contribute to its overall impression, which lies in the word itself. On the other hand, the applicant's mark consists of the word 'RAPID' presented to the left of a figurative element that the applicant describes as an image of a lens with a number of segments. While the device is noticeable, one's eye is drawn to the word elements which make the greater contribution in forming the overall impression. As for the stylisation of the word, I am of the view that this has very little impact on the overall impression of the mark.

### Visual Comparison

48. Visually, both marks share the word RAPID. The difference between the marks is the addition of a device element in the applicant's mark. While I appreciate that the colour and typeface used differ, the opponent's mark is a word-only mark registered in black and white meaning that it is capable of being used in any standard typeface and in any colour. Such use extends to the colour and typeface used in the applicant's mark. As such, these are not considered points of visual difference. Bearing in mind my assessment of the overall impression of the marks, I consider that there to be a high degree of visual similarity.

## **Aural Comparison**

49. Aurally, the opponent's mark will be articulated as 'RAPID' and pronounced in the ordinary way, as would the applicant's mark. The device element in the applicant's mark would not be articulated and therefore I consider the marks to be aurally identical.

## **Conceptual Comparison**

50. Conceptually, the ordinary dictionary word 'RAPID', identically present in both marks, will likely be perceived by the average consumer as meaning quickly or fast. As previously mentioned, the applicant states that the figurative element in their mark is an image of a lens made up of a number of segments. I do not necessarily agree that this is how the average consumer would perceive it, but even if they did, I do not believe they would attribute any concept to it to the point that it would inform their understanding of the mark. The device is a relatively simple hexagonal shape consisting of different sections. In my view the device does not convey an immediately identifiable concept. As a result, the marks are considered to be conceptually identical.

## **Distinctive character of the opponent's mark**

51. In *Lloyd Schuhfabrik Meyer & Co. GmbH v Klijsen Handel BV*, Case C-342/97 the CJEU stated that:

“22. In determining the distinctive character of a mark and, accordingly, in assessing whether it is highly distinctive, the national court must make an overall assessment of the greater or lesser capacity of the mark to identify the goods or services for which it has been registered as coming from a particular undertaking, and thus to distinguish those goods or services from those of other undertakings (see, to that effect, judgment of 4 May 1999 in Joined Cases C-108/97 and C-109/97

*Windsurfing Chiemsee v Huber and Attenberger* [1999] ECR I-0000, paragraph 49).

23. In making that assessment, account should be taken, in particular, of the inherent characteristics of the mark, including the fact that it does or does not contain an element descriptive of the goods or services for which it has been registered; the market share held by the mark; how intensive, geographically widespread and long-standing use of the mark has been; the amount invested by the undertaking in promoting the mark; the proportion of the relevant section of the public which, because of the mark, identifies the goods or services as originating from a particular undertaking; and statements from chambers of commerce and industry or other trade and professional associations (see *Windsurfing Chiemsee*, paragraph 51).”

52. Registered trade marks possess varying degrees of inherent distinctive character, ranging from the very low, because they are suggestive or allusive of a characteristic of the goods, to those with high inherent distinctive character, such as invented words which have no allusive qualities. The distinctive character of a mark can be enhanced by virtue of the use that has been made of it. The opponent has not claimed that its mark has acquired an enhanced degree of distinctiveness and did not file any evidence to that effect. As such, I have only the inherent position to consider.
53. The opponent’s mark consists of the plain word ‘RAPID’ without any additional stylisation or figurative elements. As such, the inherent distinctive character rests solely in the word itself. Whilst the word ‘RAPID’ is not considered descriptive of the goods concerned, it is a readily understood dictionary word that is considered laudatory of a feature or benefit of the software i.e., being fast in how it functions. As a result, I find that the opponent’s mark possesses between a low and medium degree of distinctive character.

### **Likelihood of confusion**

54. Confusion can be direct or indirect. Direct confusion involves the average consumer mistaking one mark for the other, while indirect confusion is where the average consumer realises the marks are not the same but puts the similarity that exists between the marks and the goods and services down to the responsible undertakings being the same or related.
55. There is no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be borne in mind (see *Sabel*, C-251/95, para 22). The first is the interdependency principle i.e., a lesser degree of similarity between the respective trade marks may be offset by a greater degree of similarity between the respective services and vice versa (see *Canon*, C-39/97, para 17). It is necessary for me to keep in mind the distinctive character of the earlier marks, the average consumer for the goods, and the nature of the purchasing process. In doing so, I must be alive to the fact that the average consumer rarely has the opportunity to make direct comparisons between trade marks and must instead rely upon the imperfect picture of them that he has retained in his mind.
56. Whilst conducting a global assessment of the likelihood of confusion I must be aware of the fact that not all aspects of the respective marks will necessarily have the same impact. For example, the importance of the respective visual, aural and conceptual aspects will be dependent on factors such as the way the goods at issue are marketed, and in which type of store/platform they are made available.
57. Throughout the course of this decision, I have determined that:
- The respective goods range from being similar to a medium degree to identical.
  - The average consumers are professional businesses seeking software to aid their business functions who will demonstrate a higher-than-

average level of attention during the purchasing process. For the broader terms such as software at large the average consumers are members of the general public who will demonstrate between low and medium level of attention during the purchasing process depending on the goods concerned.

- The purchasing process for the goods would be a combination of visual and aural.
- The opponent's mark possesses between a low and medium degree of inherent distinctive character.
- The marks at issue are visually similar to a high degree. The marks are aurally identical. The marks are conceptually identical.

58. The opponent's mark consists exclusively of the word RAPID, with no additional stylisation or figurative elements. The word RAPID is also the sole verbal element in the applicant's mark. It is therefore considered that the element of the opponent's mark which gives it its distinctive character is contained wholly within the applicant's mark. As indicated in *Kurt Geiger v A-List Corporate Limited* BL O-075-13, the likelihood of confusion is increased if the distinctive character resides in the element of the marks that are identical or similar. Thus, considering the overall levels of visual, aural, and conceptual similarity between the competing marks, I am of the view that the differences created by the fairly banal device element are likely to be insufficient to distinguish the applicant's goods from those of the opponent's. Considering imperfect recollection, it is entirely foreseeable that the average consumer, even when demonstrating a higher-than-average level of attention during the purchasing process, may not recall the respective marks with sufficient accuracy to differentiate between them. In my view, it is highly likely that the average consumer may misremember whether it is the opponent's mark that is accompanied by the simple device element, or the applicant's. I consider it far more likely that the average consumer will retain and recall the word 'RAPID'. On seeing the

applicant's goods, the average consumer may think that it is the opponent's mark, or vice versa. Consequently, I find that there is a likelihood of direct confusion.

59. For the sake of completeness, I now turn to consider a likelihood of indirect confusion. In respect of such, I remind myself of the case of *L.A. Sugar Limited v By Back Beat Inc*, Case BL O/375/10, wherein Mr Iain Purvis Q.C., as the Appointed Person, explained that:

“16. Although direct confusion and indirect confusion both involve mistakes on the part of the consumer, it is important to remember that these mistakes are very different in nature. Direct confusion involves no process of reasoning – it is a simple matter of mistaking one mark for another. Indirect confusion, on the other hand, only arises where the consumer has actually recognized that the later mark is different from the earlier mark. It therefore requires a mental process of some kind on the part of the consumer when he or she sees the later mark, which may be conscious or subconscious but, analysed in formal terms, is something along the following lines: ‘The later mark is different from the earlier mark, but also has something in common with it. Taking account of the common element in the context of the later mark as a whole, I conclude that it is another brand of the owner of the earlier mark’.

17. Instances where one may expect the average consumer to reach such a conclusion tend to fall into one or more of three categories:

(a) where the common element is so strikingly distinctive (either inherently or through use) that the average consumer would assume that no-one else but the brand owner would be using it in a trade mark at all. This may apply even where the other elements of the later mark are quite distinctive in their own right (‘26 RED TESCO’ would no doubt be such a case).

(b) where the later mark simply adds a non-distinctive element to the earlier mark, of the kind which one would expect to find in a sub-brand or brand extension (terms such as 'LITE', 'EXPRESS', 'WORLDWIDE', 'MINI' etc.).

(c) where the earlier mark comprises a number of elements, and a change of one element appears entirely logical and consistent with a brand extension ('FAT FACE' to 'BRAT FACE' for example)".

60. Whilst the three categories listed above (cited at paragraph 53 above) by Mr Iain Purvis Q.C (as he then was) do not represent an exhaustive list, they nevertheless do represent a fair reflection of instances where indirect confusion "tends to fall". The marks at issue share the common element RAPID, and whilst it may be considered laudatory, it does not have a direct descriptive meaning. Although the opponent's mark may be considered on the lower end of the scale for distinctiveness, this does not preclude a finding of confusion.<sup>2</sup> It is therefore considered that the shared word would not be considered as coincidental use but would instead point to the same origin. Further, it is my view that the additional stylisation (be that the font or device element) in the applicant's mark will be seen simply as alternative stylisations used by the same undertaking in different contexts, whether that be the word only mark being that which is used in promotional materials and the figurative the one being used on product packaging, for example. As a result, I find there to be a likelihood of indirect confusion.

## **Conclusion**

61. The opposition under Section 5(2)(b) of the Act has succeeded. Subject to any successful appeal, the application will be refused.

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<sup>2</sup> *L'Oréal SA v OHIM*, Case C-235/05 P

## Costs

62. The opponent has been successful, and, in the ordinary course of these proceedings, would be entitled to a contribution towards its costs. However, the opponent is unrepresented meaning that, in order to claim its costs, it is required to file a completed costs pro-forma. It did not do so. I note that a blank costs pro-forma was provided to the opponent under the cover of a letter from the Tribunal dated 16 March 2024. I also note that this letter set out that:

*“If the pro-forma is not completed and returned, costs, other than official fees arising from the action (excluding extensions of time), may not be awarded.”*

As no costs pro-forma was filed, the opponent incurred only the official fee to file the fast-track opposition. Bearing this in mind I make the following award of costs:

**Official Fee**

**£100**

63. I therefore order Rapid Information Systems Limited to pay Rapid Answers Limited the sum of **£100**. This sum should be paid within twenty-one days of the expiry of the appeal period or, if there is an appeal, within twenty-one days of the conclusion of the appeal proceedings.

**Dated this 23<sup>rd</sup> day of October 2024**

**Oliver Rose’Meyer**

**For the Registrar**